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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,069	02/19/2002	Bernhard Blumich	MB 102	6877

7590 12/18/2003

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EXAMINER

FETZNER, TIFFANY A

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 12/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/078,069	BLUMICH ET AL.
	Examiner	Art Unit
	Tiffany A Fetzner	2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Office Action Summary**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- NO FEE is required for reply within the period specified above, unless the minimum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the period specified above may result in abandonment of the application. See 37 CFR 1.133(b).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(d).

## Status

### Disposition of Claims

4)  Claim(s) 1-8 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-8 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.  
10)  The drawing(s) filed on 19 February 2003 is/are: a)  accepted or b)  objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTQ-152.

Priority under 35 U.S.C. §§ 119 and 120

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

13)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a)  The translation of the foreign language provisional application has been received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s).  
4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## DETAILED ACTION

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on June 20<sup>th</sup> 1999. It is noted, however, that applicant has not filed a certified copy of the DE199 28 039.8 application as required by 35 U.S.C. 119(b). Additionally, applicant claims Continuation-In-Part status of application No. PCT/EP00/05580, filed on June 16<sup>th</sup> 2000 but there are no priority papers, in the instant application establishing priority to the international PCT application. Therefore, as of the date of this action the filing date of the instant application (i.e. February 19<sup>th</sup> 2002) is the effective prior-art date of the instant application.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:

A) In **Figure 1** component **25** is shown, but there is no description of a component **25** in the specification.

B) In **Figure 2** a component **39** is shown, but there is no description of a component **39** in the specification. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. **Figures 3a and 3b** of the instant application are the same as figures 3a and 3b of us patent application publications 2002/0089330 A1 and 2002/0079891 A1 should be

designated by a legend such as --**Prior Art**-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to because applicant's figure numbers as described in the specification as Figures 1, 2, 3a, 3b and 4; but there is a stray Figure 3 above the Figures 3a and 3b. The examiner does not know what figure 3 is supposed to be since there is no brief description of a figure 3. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### ***Specification***

5. The disclosure is objected to because of the following informalities:

- A) On page 3 line 10 there is an extraneous "2)" that is not needed and confusing in the reading of the description. Please **delete** the extraneous "2)" character.
- B) On page 5 line 31 delete "**Fig. 3**" and insert "**Fig. 3a**" as only figure 3a shows gradient coil components 12 and 13.
- C) On page 12 line 5 **delete** the component number "**26**" and **insert** the number "**36**", because measuring sensitive area 36 is shown in Figure 4. The examiner notes that component 26 is a "ring thickness" as shown in Figure 1 and described on page 9 line 17, component 26 is not a "measuring sensitive area" as shown in Figure 4, and component 26 is not even a component of Figure 4. Appropriate correction is required.

#### ***Double Patenting***

6. **Claims 1-8** of this application conflict with **claims 1-8** of Application No. **10/026,067**. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.
7. A rejection based on double patenting of the "same invention" type finds its support in the language of **35 U.S.C. 101** which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).
8. **A statutory type (35 U.S.C. 101) double patenting** rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. **The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.**
9. **Claims 1-8** are provisionally rejected under **35 U.S.C. 101** as claiming the **exact same invention** as that of **claims 1-8** of copending Application No. **10/026,067**. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

10. The examiner notes that **claims 1-8** below are respectively the same as **claims 1-8** of copending Application No. **10/026,067**.

- A) **Claim 1**, "An apparatus for examining flat goods of polymeric material having reinforcement structures embedded therein, said apparatus including NMR-MOUSE (Nuclear Magnetic Resonance MOBILE Universal Surface Explorer) probes for a nuclear magnetic analysis of the flat goods".
- B) **Claim 2**, "An apparatus according to claim 1, comprising a measuring body including a measuring surface area formed by NMR-MOUSE probes for engagement with said flat goods during examination".
- C) **Claim 3**, "An apparatus according to claim 2, wherein said NMR-MOUSE probes are disposed at said measuring surface in an arrangement in which they overlap".
- D) **Claim 4**, "An apparatus according to claim 3, wherein said NMR-MOUSE probes have predetermined measurement-sensitive ranges and are so arranged that their measurement sensitive ranges overlap".
- E) **Claim 5**, "An apparatus according to claim 1, wherein said reinforcement structure comprises reinforcement filaments disposed in parallel within said polymeric material and said NMR-MOUSE probes are arranged adjacent one another in a direction normal to said filaments".
- F) **Claim 6**, "An apparatus according to claim 1, wherein said flat goods comprises a hose-like body and said apparatus consists of a cylindrical body with an annular measuring area in which said NMR-MOUSE probes are arranged for examining said hose-like body".

**G)      Claim 7**, "An apparatus according to claim 1, wherein said flat goods are examined at a warm state".

**H)      Claim 8**, "An apparatus according to claim 1, wherein said NMR-MOUSE probes are alternately controllable for providing measuring signals in succession".

11.      The **prior art made of record** and not relied upon is considered pertinent to applicant's disclosure.

**A)      Prado et al.**, US patent 6,489,767 B1 issued December 3rd 2002; which shows a single-sided NMR palm sized probe similar to but distinct from an NMR mouse.

**B)      Blumich et al.**, US patent application publication 2002/0079891 A1 published June 27<sup>th</sup> 2002 filed February 19<sup>th</sup> 2002.

**C)      Blumich et al.**, US patent application publication 2002/0089330 A1 published July 11<sup>th</sup> 2002 filed February 19<sup>th</sup> 2002; which is the publication of applicant's instant application.

**D)      Blumich et al.**, US patent application publication 2002/0079891 A1 published July 4<sup>th</sup> 2002 filed December 18<sup>th</sup> 2001; which is the publication of the application with the statutory double patented claims.

**E)      Locatelli et al.**, US patent 6,657,433 B1 issued December 2<sup>nd</sup> 2003 ; filed June 15th 2000; which shows a portable NMR measurement device, with a structure similar to but distinct from an NMR mouse.

### **Conclusion**

12.      Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tiffany Fetzner whose telephone number is: **until**

**January 27<sup>th</sup> 2003** (703) 305-0430. After **January 27<sup>th</sup> 2003** (571) 272-2241. The examiner can normally be reached on Monday-Thursday from 7:00am to 4:30pm., and on alternate Friday's from 7:00am to 3:30pm.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez, can be reached on (703) 308-3875: **until February 10<sup>th</sup> 2003** After **February 10<sup>th</sup> 2003** (571) 272-2245. The **only official fax phone number** for the organization where this application or proceeding is assigned is **(703) 872-9306**.

14. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0956.



TAF

December 9, 2003



Diego Gutierrez

Supervisory Patent Examiner

Technology Center 2800

**CHRISTOPHER W. FULTON  
PRIMARY EXAMINER**